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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/101,518      | 12/21/1998  | YI LI                | PF218US             | 9737             |

22195 7590 12/17/2001

HUMAN GENOME SCIENCES INC  
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ROCKVILLE, MD 20850

EXAMINER

PAK, MICHAEL D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1646

DATE MAILED: 12/17/2001

17

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/101,518

Applicant(s)

Li

Examiner

Michael Pak

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Sep 27, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 13-120 is/are pending in the application.
- 4a) Of the above, claim(s) 1, 13, 15-28, 33-50, 56-63, 65-73, 79-96, 102-109 <sup>111-114</sup> is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14, 29-32, 51-55, 64, 74-78, 97-101, 110, and 120 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 15
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Amendment filed 27 September 2001 (Paper No. 14) has been entered.
2. Applicant's election with traverse of Group III in Paper No. 14 is acknowledged. The traversal is on the ground(s) that Group 3 and 5 are linked so as to form a single general inventive concept because the antagonists of group 5 partially overlap. However, this is not found persuasive because under PCT Rule 13.2, they lack the same or corresponding special technical features because the corresponding PCT/US96/00499 examination indicated that Group I is anticipated by Marchese et al. (Genomics, 1995). Applicants further argue that Group 1 and 2 are linked because the unity of invention exists between protein and DNA. However, as discussed above, Group I lacks the special technical feature and thus lack unity of invention with other groups. Applicant further argue that Group 4 should be examined with Group 6 and Group 5 should be examined with Group 7. However, as discussed above, since the invention lacks special technical feature, the invention lack unity of invention.

The requirement is still deemed proper and is therefore made final.

- new P  
12/2/01*
3. Newly submitted claims <sup>33-50, 56-63, 65-73, 79-96, 102-109, 111-119 are</sup> directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Group 14: Claim 33, 41, 56, 79 and 102, drawn to an antibody which binds protein which is glycosylated, classified in class 530, subclass 387.5.

Group 15: Claim 34, 42, 57, 65, 80, 88, 103, and 111, drawn to an antibody which is

monoclonal, classified in class 530, subclass 388.1.

Group 16: Claim 35, 58, 81 and 104, drawn to an antibody which is polyclonal, classified in class 530, subclass 389.1.

Group 17: Claim 36-40, 43-47, 59-63, 66-70, 82-86, 89-93, 105-109, 112-116 drawn to an antibody which are chimeric, single chain, humanized, and human, classified in class 530, subclass 387.3.

Group 18: Claim 48-50, 71-73, 94-96, and 117-119, drawn to isolated cell which produces antibody, classified in class 435, subclass 334.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 1, 13, 15-28, 33-50, 56-63, 65-73, 79-96, 102-109, and 111-119 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP §821.3.

Claims 14, 29-32, 51-55, 64, 74-78, 97-101, 110, and 120 are examined below.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

5. Claims 14, 29-32, 51-55, 64, 74-78, 97-101, 110, and 120 are rejected under 35

U.S.C. 102(e) as being anticipated by Loetscher et al. (U.S. Patent 6,184,358)

Loetscher et al. disclose antibody directed against IP-10 receptor (columns 4, 5, 8-10, 12, 16-22, 30, 33, and 42-48). The receptor of Loetscher et al. is 99.5% identical to the claim limitation SEQ ID NO:2.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pak, whose telephone number is (703) 305-7038. The examiner can normally be reached on Monday through Friday from 8:30 AM to 2:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564.

Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

*Michael D. Pak*

Michael Pak  
Primary Patent Examiner  
Art Unit 1646  
13 December 2001